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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/614,590

07/07/2003

William C. Maloney

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09/16/2004

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EXAMINER

TRIEU, VAN THANH

ART UNIT

PAPER NUMBER

2636

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/614,590	Applicant(s) MALONEY, WILLIAM C.	
	Examiner Van T Trieu	Art Unit 2636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/8/03; 10/14/03; 3/2/04 x 7/12/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: in the specification, page 1, line 20, after the phrase "application" insert

--- is a continued in part of U.S. Application No. 10/122,507 filed on 14 April 2002, which is a continuation of U.S. Application No. 09/797,338 filed on 01 March 2001, now U.S. Patent No. 6,407,665, which is a continuation of U.S. Application No. 09/393,223 filed on 09 September 1999, now U.S. Patent No. 6,204,764, which ---- .

Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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2. Claims 1-32 are rejected under the judicially created doctrine of double patenting over claim 1-24 of U. S. Patent No. 6,204,764 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the claimed limitations are the same between them.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

3. Claims 33-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 25-28 of U.S. Patent No. 6,204,764 in view of U.S. Patent No. 6,075,441. The combination of periodically transmitting the codes of objects present at the location by RF transmission is obvious since the RF communications are adapted to use for tracking to determine a location of the objects by periodically checking of the object identification assembly.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

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by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claim 33 is rejected under 35 U.S.C. 102(e) as being anticipated by **Frederic** [US 6,788,997].

Regarding claim 33, the claimed method of determining the absence or presence of objects at a location, the method comprising the steps: (a) providing each of the objects with a code identifying the object (the boxes, compartments 126, containers or drawers 620 with a unique identification code, each of them for storing medical pills or objects to be monitored and tracked, see Figures 40-47, 57 and 61-63, col. 2, lines 50-61, col. 3, lines 1-22, col. 4, lines 23-39, col. 5, lines 43-65 and col. 36, lines 4-56); and the periodically transmitting the codes of objects present at the location by radio frequency transmission, see col. 4, lines 47-52, col. 8, lines 50-57, col. 24, lines 15-19, col. 53, lines 32-37, col. 61, lines 18-27 and col. 62, lines 54-61); and the receiving the transmitted codes by radio frequency reception, see col. 53, lines 32-37); and the determining based on the received codes with objects are present at the location and which objects are absent from the location, see col. 3, lines 64-67, col. 4, lines 1-3 and 23-52, col. 61, lines 18-27 and col. 62, lines 54-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Frederick** [US 6,788,997].

Regarding claim 34, **Frederick** fails to disclose the RFID tag is attached to the object to be tracked. However, **Frederick** teaches that the electronic reading device 348 connects to the system by wireless communication methods, such as IR or RF, for reading each of the boxes, compartments 26, containers or drawers 62, which include labels, bar codes, identification cards or badges to store identification data of each medical and its locations, see Figs. 39-49, col. 4, lines 23-52, col. 8, lines 44-64, col. 9, lines 1-27, col. 24, lines 8-18, col. 42, lines 13-30, col. 50, lines 56-67, col. 53, lines 32-37, col. 61, lines 18-27 and col. 66, lines 34-41. Therefore, it would have been obvious to one skill in the art to recognize that the labels, ID cards or badges are electronic tag having memory for storing information data and for transmitting/receiving the information data to the reading device by RF communications.

Regarding claim 35, all the claimed subject matters are discussed in respect to claim 34 above, and including the arrays of readers, see Fig. 40, col. 24, lines 8-18.

Regarding claim 36, all the claimed subject matters are discussed in respect to claim 35 above, and including the capacitive coupling, see col. 53, lines 35-37.

Regarding claim 37, all the claimed subject matters are discussed in respect to claim 35 above, and including the inductive coupling, see col. 53, lines 35-37.

Regarding claim 38, all the claimed subject matters are discussed in respect to claims 33 and 35 above.

Regarding claim 39, all the claimed subject matters are discussed in respect to claims 33 and 38 above.

Regarding claim 40, all the claimed subject matters are discussed in respect to claim 39 above, and including the dynamically removal and replacement of objects at the location (the restocking process, see col. 9, lines 1-27)

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

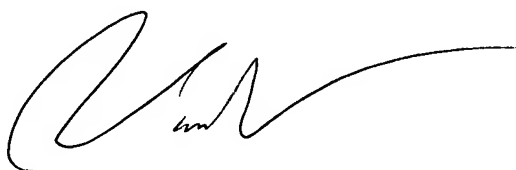
Morello et al discloses an apparatus for dispensing and returning reusable articles each identifiable with its own ID. [US 4,967,906] and [US 4,896,024]

Highham et al discloses a method for dispensing medical supply or pharmaceutical items comprising a processor, a cabinet having a plurality of drawers, which includes a plurality of pins for holding medical items. The medical items are monitoring and tracking. [US 5,905,653] and [US 5,745,366]

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7. Any inquiry concerning this communication or earlier communications from examiner should be directed to primary examiner **Van Trieu** whose telephone number is (571) 272-2972. The examiner can normally be reached on Mon-Fri from 7:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. **Jeffery Hofsass** can be reached on (571) 272-2981.

A handwritten signature in black ink, appearing to be 'Van Trieu', with a long horizontal flourish extending to the right.

Van Trieu
Primary Examiner
Date: 9/10/04